

## REMARKS

Claims 8 and 9 have been amended. The Examiner indicates claims 7, 10, and 11 to be withdrawn, and Applicant disagrees. Claims 2-4 and 7-11 remain pending. Reconsideration and reexamination of the application, as amended, are requested.

The Examiner imposed a restriction requirement. The Examiner then indicated that the invention had been constructively elected. Applicant disagrees. All pending claims were examined and prosecuted in the last Response, although it was indicated by Applicant that newly presented claim 8 replaced claim 1, newly presented claim 10 replaced claim 6, and claim 9 was a new method claim similar to the process claimed in the product by process claim of claim 8 and claim 11 was a method claim similar to the process claimed in the product by process claim of claim 10. Applicant submits that there was not a constructive election. Furthermore, the Examiner states the restriction as follows:

- I.      Claims 8, 9, and 2-4, drawn to a multi-layer metal tube, classified in class 138, subclass 109.
- II.     Claims 10, 11, and 7, drawn to a method of bending metal tubes, classified in class 72, subclass 370.06.

This is incorrect. Claims 8 and 10 are product by process claims. Claims 9 and 11 are method claims corresponding to the processes claimed in the product by process claims. The pipe members of claims 8 and 10 result in similar products, although the pipe member of claim 8 has different diameters, while the pipe member of claim 10 has substantially the same diameter. The processes of claims 8-9 and of 10-11 are somewhat different. It is submitted that the Examiner's discussion that the inventions are distinct is clearly incorrect. Applicant requests that the restriction requirement be withdrawn.

If the restriction requirement is not withdrawn, Applicant elects Group I, claims 8, 9, and 2-4, with traverse.

The Examiner rejected claims 8, 9, 2, and 3 under 35 U.S.C. 102(b) as being anticipated by Reed.

The Reed patent is directed to a method of making duplex wall tubing. The tube walls 1 and 2 are concentrically arranged with welds 6, 7 at opposite ends. A forming apparatus with a ball 8 and an induction heating coil 11 are progressively moved axially with respect to the concentric tube walls to expand the inner wall and bond the tubes together.

Reed does not disclose moving one of a metal pipe of a larger diameter and shorter length and a metal pipe of a smaller diameter and a longer length. As a result of this feature required by the claims and not disclosed in Reed, because one of the metal pipes is shorter than the other, when the two pipes are engaged a multiple-pipe structure is formed. Then, as specified in claim 8 and claim 9, during the expansion at least a portion of only the multiple-pipe structure is expanded. Thus, necessarily only the multiple-pipe structure is re-formed. With respect to claims 8 and 9, the product pipe member has at least a portion of the longer, smaller diameter, metal pipe unchanged while the multiple-pipe structure is expanded. Such product pipe member of claims 8 and 9 is different structure from the duplex wall tube of Reed. Reed does not anticipate claims 8, 9, 2, and 3.

The Examiner rejected claims 8, 9, and 2-4 under 35 U.S.C. 102(b) as being anticipated by Everson.

Everson is directed to the manufacture of compound tubes. The method of Everson makes use of a mandrel wherein a billet 5 is placed on the mandrel and rolled to form an inner tube 6. The inner tube is then inserted within the outer tube 7. With the expander 4 in place, the mandrel and expander are withdrawn so that the inner tube is expanded to tightly fit within the outer tube. Any enlargement of the combination of the inner and outer tubes is eliminated when a finishing mandrel 9 is placed within them and the compound tube is rolled to reduce the size to the original standard size of the outer tube.

As discussed above with respect to Reed, Everson also does not disclose the method of claims 8-9 and the resulting structure. Thus, Everson cannot anticipate claims 8, 9, and 2-4.

For similar reasons, claims 10-11 are patentable over the cited references.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration and reexamination are requested. Allowance of claims 2-4 and 7-11 at an early date is solicited.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(612) 332-5300

Date: 9-4-04

Curtis B. Hamre  
Curtis B. Hamre  
Reg. No. 29,165  
CBH:njo:lad

